JOHN T. FEY, Clerk

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IN THE

Supreme Court of the United States

OCTOBER TERM A. D. 1956

No. 523

ALVA G. BLANCHARD,

Petitioner

versus

ROBERT C. WATSON, Commissioner of Patents,

Respondent

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT.

ALVA G. BLANCHARD
3618 Fairfield Avenue
Shreveport, Louisiana
In propria persona,
for Petitioner.

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SUPREME COURT OF THE UNITED STATES

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NO. _____

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vs.

ROBERT C. WATSON, Commissioner of Patents,
Respondent

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Alva G. Blanchard, your petitioner, prays that a Writ of Certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia Circuit, decided in the above entitled case on May 31, 1956.

OPINIONS BELOW

The Court of Appeals affirmed (Appendix A, page A10) on the opinion of Judge Morris of the United States District Court for the District of Columbia, which opinion (Appendix A, pages A7-A9) is reported at 132 Fed. Supp. 744.

JURISDICTION

The judgment of the Court of Appeals was decided on May 31, 1956 (Appendix A, Page A10). The jurisdiction of this Court is invoked under the provisions of 28 U. S. C. A. §1254 (1), Appendix D, pages D2 and D3.

QUESTIONS PRESENTED

1. In a patent matter, can a Patent Office rule which prohibits reservations of subject matter disclosed but not claimed in a pending application be construed to also apply to a reservation in an amendment, made in good faith by the petitioner on the suggestion of the examiner of subject matter both claimed and disclosed.

2. In a patent matter, may prior art patents not cited by the Examiner in the patent office be introduced for the first time in the District Court with no expert testimony as to their pertinency and bypass Rule 106 of the Rules of Practice in the United States Patent Office, Appendix D, page D6, which provides in part:

> "- - - In rejecting claims for want of novelty or for want of invention, the examiner must cite the best reference at his command. - - - - - The pertinence of each reference, if not obvious, must be clearly explained and each rejected claim specified."

or should the case be remanded to the Patent Office for a proper rejection in accordance with said Rule 106?

3. In a patent matter, may claims in a pending application be rejected by citing prior art references that may accomplish similar results but in a different manner with more and different elements than are contained

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in the rejected claims?

4. In a patent matter, was there continuous prosecution of the subject matter of three (3) generic claims from an original application, which would bar the use of a species claim patent issued in a co-pending application as a reference?

STATUTES AND REGULATIONS INVOLVED

The statutes and regulations involved are set out in Appendix D, Pages D1 - D6.

STATEMENT

This action originated under the Patent Laws of the United States in the rejection of generic claims 1, 2 and 3 in a divisional application filed March 4, 1945, Serial No. 581,373. (Appendix B, page B2, lines 3 and 4).

This is a divisional application and was divided by requirement from an earlier divisional application filed February 20, 1941, Serial No. 379,822 in which the rejected claims appeared substantially the same as claims 8, 9 and 10. (Appendix B, page B1).

This divisional application was divided at the suggestion of the patent office from an earlier original application filed October 14, 1935, Serial No. 44,988, in which the subject matter of claims 8, 9 and 10 appeared as generic claim 15. (Appendix B, page B1).

After the original application was filed containing generic claim 15 on October 14, 1935, an active infringement was attracted. To meet this active infringement, an application was filed containing only species claims of Petitioner's invention, on May 28, 1938, which was assigned

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Serial No. 210,585. (Appendix B, page B1). It was made "special" as the active infringer also put in an application for a patent and an interference proceeding developed. The infringer's earliest date of conception was after petitioner's filing date, and the interference was settled with the patent issued to appellant on May 7, 1940, No. 2,199,611, (Appendix C, pages C1 to C3), which is petitioner's species patent in the co-pending application.

Prosecution of the original application with generic claim 15 and others continued. The requirement for division was contested and finally all claims were rejected, with the Examiner's statement to the Board of Patent Appeals containing the following statement:

> "Claims 15 to 17 stand rejected on House in view of Fulton as urged in connection with claims 1 to 5. These are organization claims. Therefore, the Examiner does not consider that specific features of appellant's valve construction are germane to the invention claimed. The Examiner has held that any novelty in appellant's valve construction per se is subject matter for separate applications." Emphasis ours. (Appendix B, page B3).

The Board of Appeals sustained the Examiner (Appendix A, pages A3 to A6), except as to claim 14, which was allowed. This decision was appealed to the District Court for the District of Columbia. While the case was waiting for trial, appellant had a conference with the Examiner which resulted in the following agreement:

1. That the case would be withdrawn from the District Court.
2. That claim 14 and similar claims would be allowed on the original application.

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3. That appellant would cancel all claims except 14 and refile the subject matter of the cancelled claims before the patent issued on the original application.

Pursuant to this understanding, petitioner directed a letter to the patent office on April 6, 1940, setting out additional claims similar to claim 14 and withdrawing all other claims in the following words:

> "Cancel all claims except 14 and applicant reserves the right to amend the cancelled claims and make them the subject matter of divisional applications." (Appendix B, page B3, lines 1 to 3).

Petitioner started the preparation of the divisional application to contain the subject matter of the withdrawn claims and it appearing that the application could not be completed before the Patent would issue on the original application with claim 14 and similar claims, a delay in issue was asked for and granted. The request was dated December 5, 1940, as follows:

> "At this time we have another application pending, which is a partial division of this application, but we have not quite completed it for filing yet.
>
> We would therefore, like to have the publication of this patent, (Application No. 44,988) held ninety days, or the limit for getting this out." (Appendix B, page B3, lines 15 to 19).

In due course the divisional application with the generic subject matter of Claim 15, as claims 8, 9 and 10 was filed on February 20, 1941, Serial No. 379,822, which was about two weeks before the patent issued on the original application Serial No. 44,988 on March 4, 1941, No.

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2,233,395.

Prosecution of the aforementioned application Serial No. 379,822 with generic claims 8, 9 and 10, containing the subject matter of generic claim 15 was continued until division was required again, at which time generic claims 8, 9 and 10 were continued as claims 1, 2 and 3, in a divisional application Serial No. 581.373, filed March 7, 1945, which was almost a year before the patent issued on application Serial No. 379,822, on February 19, 1946. No. 2.395,212. Claims 1, 2 and 3 are the claims in suit and were rejected only for double patenting, citing as a reference petitioner's patent No. 2,199,611 of May 4, 1940.

Petitioner reminded the examiner that such a reference as this, a species patent issued on a co-pending application, should not be used, and that claims 1, 2 and 3, through claims 8, 9 and 10, had their origin in claim 15 of the original application. The patent office then contended that claims 8, 9 and 10 were not the same as claim 15, in spite of the fact that every element of claims 8, 9 and 10, as well as claims 1, 2 and 3 are present in claim 15.

The patent office then claimed the reservation clause could be separated and that part of the sentence "cancel all claims except 14" could be taken alone out of context with the balance of the sentence, as cancelling the claims so as to establish a hiatus from the date of the cancellation reservation sentence and the refiling date, during which time the species claim patent issued.

The patent office further ruled that the lapse of time between April 6, 1940 when claim 15 was withdrawn for refiling, and February 20,

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1941, when claims 8, 9 and 10 were filed created a fatal hiatus insofar as claims 1, 2 and 3 are concerned. Petitioner then advised the examiner that the withdrawal was not a cancellation period, but was a cancellation with a reservation that had for its effect the withdrawal of the subject matter.

When no relief was granted to petitioner in the patent office, a petition was filed in the United States District Court for the District of Columbia. At the time of the filing of this petition, the disputed claims had been rejected by the examiner only for double patenting.

In the District Court, it was suggested that the cancellation-reservation clause was void under Rule 44, and therefore the hiatus existed and the species claim patent barred the three generic claims. Also that the claims were anticipated by three old prior art patents. The Court of Appeals upheld these views.

REASONS FOR GRANTING THE WRIT

The court below made two mistakes.

It held that Rule 44 applied so as to create the fatal hiatus during which time the species claim patent issued and that the prior art patents did preclude the issuance of the patent without any evidence whatsoever that they contained elements that did perform the functions of the three rejected claims.

1. "Rule 44. A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application." Rules of Practice in the United States Patent Office.

To understand how Rule 44 was applied by Judge Morris in the

District Court, and why it does not properly apply, consideration must be given to several events which occurred before Rule 44 was brought into the case. Under the reasoning of Judge Morris, his sole justification for applying the rule is the allegation that there existed a period between April 6, 1940, when Claim 15 of Application No. 44,988 was withdrawn for refiling and February 20, 1941 when Claims 8, 9 and 10 were filed in Application No. 379,822 when the subject matter of Claim 15 was disclosed (in Application No. 44,988) but not claimed, and as a matter of fact was not claimed until it was refiled as Claims 8, 9 and 10 of Application No. 379,822. This reasoning is obviously faulty. A consideration of the conditions at the time of making Rule 44 clearly shows the error in applying this rule in the present case.

Rule 44 was passed to take care of a particular historical situation which existed up until its passage. Prior to the passage of Rule 44, the question of reservations in applications was discussed in Ex Parte Blair, 188 C. D. 16. In that connection the Commissioner stated:

> "I understand that it has uniformly been the practice of the Office to require the reservation Clauses in applications to be stricken out in order to compel the applicant to file his second application and have it pending concurrently with the first, and when that has been done and the merits of the application have been settled, to consider whether cross references are necessary and whether patents should issue at the same time . . . . . he has filed a separate application for the process but he has not yet filed an application for the apparatus, and he may never do so; but by introducting a reservation clause into the present application and carrying it into his patent, in case one were granted, he would thereby

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> erect a warning by which the public would be deterred from entering upon this field of invention, and also would be prevented from knowing just what property it was purchasing in dealing with such a patent . . . . . This is the policy of the requirement, and it is the only power the Office possesses by which it can control to this extent the action of applicants, protect the public against the extension of a monopoly. and secures their rights to the unclaimed inventions shown in patents . . . . . In my opinion, there should be a rule forbidding the introduction of reservation clauses in applications; but I feel satisfied that, in the absence of the rule, the Commissioner has the power, and it is the proper practice, to discourage their employment and to require their cancellation." (Emphasis ours.)

This would indicate that the situations which brought about Rule 44 were where an applicant seeks to make reservations in the body of the application as distinguished from an amendment preparing the application for allowance.

To better understand the problem of applying Rule 44 it helps to reduce it to its essential elements: (1) a reservation (2) in a pending application (3) for a future application and (4) for subject matter disclosed but not claimed in the pending application.

The first two elements of Rule 44 contemplate a reservation in a pending application. In the case at bar, the reservation involved was not made in an application, but was made in an amendment to the application pursuant to a suggestion of the examiner. The words of the cancellation were:

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> "cancel all claims except 14 and applicant reserves the right to amend the cancelled claims and make them the subject matter of divisional applications."

It is obvious from this wording that the cancellation depended for its validity upon the validity of the reservation. The solicitor for the patent office has taken the attitude that the words "cancel all claims except 14" may be removed from context and be taken to mean that an absolute cancellation was intended when petitioner's obvious intention was to withdraw all claims except 14 pending their refiling in divisional application. Petitioner never doubted the validity of the reservation since it not only was made at the suggestion of the examiner, but was not a part of the application as is required by Rule 44. An application is defined as:

> "51. General Requisites of an Application. Applications for patents must be made to the Commissioner of Patents. A complete application comprises:
>
> (a) A petition or request for a patent, see Rule 61.
>
> (b) A specification, including a claim or claims, see Rules 71 to 77.
>
> (c) An oath, see Rule 65.
>
> (d) Drawings when necessary, see Rules 81 to 88.
>
> (e) The prescribed filing fee. (see Rule 21 for filing fees.)"
> Rules of Practice in the United States Patent Office. (Emphasis ours.)

While transactions occurring between the applicant and the examiner subsequent to the filing of an application all go to make up part of the "file wrapper," material not actually a physical part of the application as defined by Rule 51 would not come within the purview of Rule 44. It is accordingly submitted that the first two requisites of Rule 44, (1) a reser-

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vation (2) in a pending application, are not met in this case.

Rule 44 also requires that the reservation, to be invalid, must be a reservation which applies to subject matter disclosed but not claimed in the pending application. In this case, the subject matter was always disclosed as Claim 15 and was claimed first as Claim 15, then as Claims 8, 9 and 10, and now as Claims 1, 2 and 3. It is obvious then that this requirement of Rule 44 is not met.

To clear up any ambiguities which had previously existed, and which caused misapplication as in the case at bar, Rule 44 has been replaced in the Rules of Practice by Rule 79, which reads as follows:

> "79. Reservation Clauses not Permitted. A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application, but an application disclosing unclaimed subject matter may contain a reference to a later file application of the same applicant or owned by a common assignee disclosing that subject matter." Rules of Practice in the United States Patent Office, September 1955.

This language clearly shows that there was never any intent for Rule 44 or Rule 79 to apply in such cases as this. To apply Rule 44 as it has been applied in this case, amounts to tricking an applicant into losing valuable claims by permitting the Patent Office to:

(1) Suggest to an applicant that subject matter of certain claims might with impunity be made the subject matter of separate applications by making a reservation by amendment;

(2) After a good satisfactory cancellation with a reservation of the subject matter of the cancelled claims of the original application, allowing the invocation of Rule 44 to nullify the reservation by improperly applying Rule 44; and

(3) Permitting a cancellation by denying the reservation on which said cancellation was based.

To sanction this line of reasoning as the district court and court of appeals have done leaves the door open for the Patent Office to practice trickery in getting applicants to lose valuable claims that they would otherwise be entitled to, and would cause unwary applicants to lose valuable patent rights without due process of law as guaranteed by the United States Constitution.

2. The Courts below erred in regard to the prior art in two respects:

1. The prior art was introduced by the solicitor in direct contravention of the Rules of Practice in the United States Patent Office.

2. The prior art cited does not read on petitioner's invention.

In this case. Petitioner's generic claims 1, 2 and 3 have been rejected (1) on double patenting citing Petitioner's species claim Patent No. 2,199,611 of May 7, 1940 and (2) for anticipation in the old prior art as shown by the following: (See Appendix C, pages C1 to C13)

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Singleton, Re. 7,767, June 26, 1877

McLaughlin, 458.794, September 1, 1891

Clark 683,021, September 24, 1901.

The prior art cited should have been disallowed by the District Court purely on the strength of Rule 106 of the Rules of Practice in the United States Patent Office:

> "106. Rejection of claims.
> If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.
>
> In rejecting claims for want of novelty or for want of invention the examiner must cite the best reference at his command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not obvious, must be clearly explained and each rejected claim specified." (1955 Rules of Practice in the United States Patent Office)

The prior art should not have been admitted to the lower Court because there was no witness to testify as to its pertinency or that it was "newly" found. Had there been, Petitioner could have discredited it by cross examination or other witnesses to the contrary.

Had it been cited by the Patent Office, the Examiner, as required by Rule 106 of the Rules of Practice in the United States Patent Office, would have been required to explain clearly exactly how the references applied to the claims rejected. If the examiner was not correct, it would be perfectly clear to any later reviewing court. The Petitioner is entitled to this clear explanation that the rule says "must" be given when rejecting

a claim; the patent law puts the burden of proof on the Examiner to explain how a prior art patent negatives invention as stated in Rule 106, and by considering this prior art without the Patent Office first having considered them, and giving their reasons in writing, the burden was shifted to the applicant, which was obviously not the intent of the patent law.

From reading Judge Morris' memorandum, Appendix A, pages A7 to A9, it is obvious that the prior art cited was misapplied in the District Court. Judge Morris said of the prior art patents that they "have elements which perform the functions of the elements in plaintiff's claims, and do preclude the issuance of patents on such claims." A prior art patent sufficient for the examiner to use as an anticipation must have all of the same identical elements of a claim in order to disallow the claim on the prior art. In this instance, though cited separately and not in combination, all of the prior art cited put together does not have all of the elements of any of the three rejected claims. It should be noted that Judge Morris of the District Court did not say that the prior art had all of the elements of each rejected claim, but "have elements which perform the functions of elements in plaintiff's claims, and therefore preclude the issuance of patents on such claims." This wording of Judge Morris' judgment shows that he was mistaken in his conception of the law. The law is, to negative invention, the prior art must disclose the combination of the same elements in a claim, because it is the combination of elements that makes the claim and not their function.

The law on what constitutes prior art is well settled as expressed in Walker on Patents, Vol. 3, Deller's Edition:

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> "§ 461 - Omission -
> Omission of 1 element or ingredient of a combination covered by any claim of a patent, averts any charge of infringement based on that claim."
> 10 or more citations beginning with Prouty v. Ruggles 16 Pet. (41 U.S. 431, 1842)and ending with Weatherford v. Coupe 147 U.S. 322, 1893"

The law as to the necessity of using all the elements of a claim in order to infringe that claim is expressed on page 1697 of the same reference as follows:

> "A combination is an entirety. If one of its elements is omitted, the thing claimed disappears. Every part of the combination claimed is conclusively presumed to be material to the combination, and no evidence to the contrary is admissible in case of alleged infringement." About 15 cases are cited as holding this law, beginning with Vance v. Campbell, 1 Black (66 U.S.) 427, 450; 17 L. Ed. 168 (1891) and ending with Electric Protection Co. v. American Bank Protection Co. 184 Fed. 916 (1910).

The law as to the avoidance of infringement by leaving out one element is set out on page 623 of Patent Law and Practice by Amdur as follows:

> "In other words, if a patentee introduces an unnecessary element into the claim for his invention, and another discovers that such element is unnecessary or superfluous, and thereby does not use it, but makes a structure otherwise identical with that of the patent, is he an infringer? This point has been passed upon many times -- the defendant does not infringe the claims in issue." Loraine Development Co. v. General Electric Co. 198 Fed. 100, 113, 116 (N.D. N.Y. 1912).

From the foregoing law the conclusion must be that elements of claims are limitations and are strictly construed.

To determine whether or not a prior art patent anticipates a proposed claim, it is the general practice to separate the proposed claim into its elements and then lay each one of these elements over the cited reference. If each of the elements is present in the reference, the claim is, of course, unpatentable. If each of the elements is not present in the reference, the reference is inadequate as it is the combination of elements that makes the claim.

The art cited is completely without merit and was an obvious subterfuge on the part of the Solicitor for the Patent Office to cloud the issue. It appears that the art cited is just something that the Patent Office turned up from its indices that looks something like Petitioner's device.

3. There has been no double patenting, and therefore no hiatus in suit. The law is old and very clear that a species claim patent in a divisional application may not be used against generic claims not yet allowed that have been continuously prosecuted from the original application.

> "Where species claim issues on an application which is a division or continuation in part of an earlier application containing generic claims, the generic claims may issue last provided they have been continuously prosecuted from the beginning. The issued species claim patent may not be cited against the generic claims that have not yet been allowed." Ex Parte Reuter, 61 U.S.P.Q. 65; Vapor Car Heating Co. v. Gold Car Heating and Lighting Co. 296 F. 188, 16 F. 2nd 194, 268 U. S. 705.

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This law has been further clarified and brought up to date by the Patent Law enacted July 12, 1952 to be cited as follows:

> "35 U. S. C. 121. DIVISIONAL APPLICATIONS. If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of Section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the Courts against a divisional application or against the original application or on any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention." (Emphasis ours).

Section 4 (a) of the Patent Act of July 19, 1952. (Public Law 593, 82nd Cong., 2nd Sess. ch. 950; 55 Stat. 792) provides:

> "This act shall take effect on January 1, 1953 and shall apply to all applications for patent filed on or after such date and to all patents granted on such applications. It shall apply to further proceedings on applications pending on such date and to patents granted on such applications except as otherwise provided." (Emphasis ours).

Respondent claims that the generic claims 1, 2 and 3 were not in

the original first filed application but were first introduced as claims 8, 9 and 10 on February 20, 1941, and denies claim 15 of the original application contain their substance.

The law appears to be, that to show continuous prosecution of generic claims from the original application, it is not necessary that they be in exactly their same form all the way back. If this were not so, a generic claim could not be amended to meet an Examiner's objection and it could not be put in form for allowance. This view is supported as follows:

> "No rule of law compels applicant to put in parent patent containing generic claims all specific claims devisable thereon." Ex Parte Jeffry and Mitchell. (P. O Bd. App.) 60 U S. P. Q. 424.

Petitioner avers that claims 8, 9 and 10 above referred to, are the patentable substance of claim 15 of the original application. Claim 15 is acknowledged to be present in the original application.

Generic claims 1, 2 and 3 in suit are easily shown to be divisible from original claim 15 by comparing the elements of claims 1, 2 and 3 with the elements of Claim 15 from which they are drawn. To facilitate the comparison, it may be stated that generic claims 1, 2 and 3 embrace only one idea or invention. The idea is stated in three claims because the Courts have for many years confirmed an applicant's right to restate his invention in a reasonable number of ways (MANUAL ON PATENT EXAMINING PROCEDURE Section 706. 03 K).

Respondent asserts that even if continuous prosecution of generic claims from the original application could otherwise be shown, claim 15

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was cancelled on April 6, 1940; the application carrying forward the subject matter of claim 15 as claims 8, 9 and 10 was not filed until February 20, 1941, which was al most a year after Petitioner's species patent claim issued on May 7, 1940.

Petitioner denies that claim 15 was cancelled within the usual meaning of the word. It was not cancelled but was withdrawn from the original application as the result of a conference with the Examiner. The purpose of withdrawing claim 15 was to make it and the other withdrawn claims the subject of a new application and for the additional purpose of preparing the additional claims thought allowable at the conference.

The actual wording of this reservation was as follows:

> "Cancel all claims except 14 and applicant reserves the right to amend the cancelled claims and make them the subject matter of divisional applications."

This wording cannot possibly mean anything except that the cancellation was contingent on the allowance of the reservation. The intention was the withdrawal of these claims to refile in another application before the issue of the patent on the original application.

To further show that the wording of Petitioner's letter of April 6, 1940 was intended and accepted only as a withdrawal of these claims for the purpose of refiling them in a divisional application as suggested by the Examiner before the patent issued on the original application S.R. No. 44,988, Petitioner wrote a "delay in issue request" to the Patent Office on December 5, 1940, as follows:

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SIDNEY YOUNG, COURT REPORTER, 418 FEDERAL BLDG., SHREVEPORT, LA.

> "At this time we have another application pending, which is a partial division of this application, but we have not quite completed it for filing yet. We would therefore like to have the publication of this patent (Application No. 44, 988) held ninety days or the limit for getting this out."

This request was granted as the patent on original application S. R. 44,988 issued on March 4, 1941, No. 2,233,395, about two weeks after the generic subject matter of original claim 15 was carried forward in application S. R. 379,822 filed February 20, 1941, as claims 8, 9 and 10.

CONCLUSIONS

The ruling in the Courts below injects uncertainty and inconsistencies into the patent system. This petition for a writ of certiorari should therefore be granted.

Respectfully submitted,

Alva G. Blanchard

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